



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/520,941

08/30/2005

Kimio Ishimaru

4752-003

4769

22429

7590

06/09/2010

LOWE HAUPTMAN HAM & BERNER, LLP  
1700 DIAGONAL ROAD  
SUITE 300  
ALEXANDRIA, VA 22314

EXAMINER

SKINNER, SHEWANA D

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

06/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,941	<b>Applicant(s)</b> ISHIMARU ET AL.	
	<b>Examiner</b> SHEWANA SKINNER	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/12/2005, 8/30/2005, 1/30/2009</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This communication is a First Action Non-Final on the merits. **Claims 1-14**, as originally filed, are currently pending and have been considered below.

#### ***Information Disclosure Statement***

1. The information disclosure statements filed 1/12/2005 and 8/30/2005 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. They have been placed in the application file, but the information referred to therein has not been considered.

#### ***Claim Objections***

2. **Claims 4, 6 and 8** are objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claim 3. See MPEP § 608.01(n). Accordingly, the claims 4,6 and 8 have not been further treated on the merits.

3. Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3 and 4. See MPEP § 608.01(n). Accordingly, the claim 5 has not been further treated on the merits.

4. Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3 and 6. See MPEP § 608.01(n). Accordingly, the claim 7 has not been further treated on the merits.

Art Unit: 3689

5. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3 and 6. See MPEP § 608.01(n). Accordingly, the claim 8 has not been further treated on the merits.

6. Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3 and 8. See MPEP § 608.01(n). Accordingly, the claim 9 has not been further treated on the merits.

7. Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3, 8 and 9. See MPEP § 608.01(n). Accordingly, the claim 10 has not been further treated on the merits.

8. Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3-10. See MPEP § 608.01(n). Accordingly, the claim 11 has not been further treated on the merits.

9. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because of multiple dependent claims 3-11. See MPEP § 608.01(n). Accordingly, the claim 12 has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1, 13 and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to how a processing section that is

Art Unit: 3689

defined within the specification as a CPU is able to provide a material such as a sample and strain. Therefore, the claims are indefinite.

11. **Claims 1, 13, and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. How does a processing section that is defined as a CPU obtain a dividend Dt to a research-and-development intermediary organization and a dividend Dr to a research organization on the basis of consideration income obtained by technology transfer, which includes the information-disclosure charge LA” where "obtain” is defined by Webster’s Dictionary as to gain or to attain. Examiner is unclear as to how a CPU gains or attains a dividend to an entity? Therefore, the claims are indefinite.

12. **Claim 14** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The medium being used is undefined and therefore, the claim is indefinite.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. **Claim 13** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The present claims are directed to merely a program executed on a computer. The program does not claim a medium and thus, the claim amounts to software

Art Unit: 3689

program per se. A software program per se is considered nonfunctional descriptive material that does not fit into the four statutory classes of method, apparatus, an article of manufacture and composition of matter and is therefore non-statutory subject matter.

14. **Claim 14** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is drawn to a computer-readable medium having a program stored thereon, however the specification fails to define the medium, which creates the possibility that the medium is a signal where signals are non-statutory subject matter. Therefore a claim drawn to such an undefined computer readable medium that covers both transitory and non-transitory embodiments must be amended to narrow that claim to only statutory embodiments to overcome a rejection under 35 U.S.C. § 101 by adding the limitation "non-statutory" to the claim.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Frank et al (US 7,127,405)*, hereinafter "*Frank*".

**As per Claims 1-3, 13 and 14**, *Frank* disclose a system, computer-readable medium with a program for performing the method of managing the life cycle of intellectual property (*col 4 lines 16-18 and col 14 lines 18-24 and 51-54*) where possible types of intellectual property are

Art Unit: 3689

disclosed, selected and developed (*col 17 lines 22-34 and col 6 lines 46-53*) and data about the property is collected and disclosed (*col 17 lines 31-34, col 4 lines 44-58 and col 5 lines 12-15*).

Contracts pertaining to the IP are then created and stored via the server depending on the terms, conditions and intentions of the contracting parties (*col 7 lines 45-67 through col 8 lines 1-5, col 12 lines 63-64, col 30 lines 60-67 through col 31 lines 1-4 and col 35 lines 24-67 where the contract database has fields that dictate what type of contract will be formed, col 60 lines 38-5 and col 103 lines 43-48*) where the cost of the contracts is determined and stored in the financial information data i.e. revenue cost, license fees and royalties (*col 9 lines 17-19, col 12 lines 62-63, col 57 lines 59-62, col 58 lines 31-35, col 60 lines 56-65*) and display said contract to the user (*col 62 lines 4-10*).

Although *Frank* discloses the method and system of creating contracts based on the type of contract and dependent on the terms of the contract between parties where said terms include costs and revenues (*col 7 lines 45-67*), it does not explicitly state the type of cost being the cost for information disclosure. However, examiner takes official notice that it is well known in contracts to set charges pertaining to the terms of the contract, which in this case would be the charge of disclosing the information of a potentially patentable invention and that charging for disclosing information is well-known when forming contracts for the right to use intellectual concepts (i.e. patents)

Therefore, as both the official notice statement and *Frank* disclose the concept of contract formation and the terms used, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of the official notice statement with the reference of *Frank*, as *Frank* teaches the creation of contracts when involving intellectual concepts (i.e.

Art Unit: 3689

patents) using terms such as cost and the official notice statement teaches that the cost to disclose information is a common term featured in contracts for intellectual concepts (i.e. patents) where said combination would create a contract type that is well-known in the field of intellectual property disclosure and licensing.

### ***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Rivette et al (US 2003/0046307)*, *Germeradd et al (US 2002/0035499)*, *Sick et al (US 2002/0040338)*, *Goodman et al (US 2004/0122841)*, *Prokoski (US 2002/0046038)* and *Vollenweider et al (US 2008/0091620)*..

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHEWANA SKINNER/  
Examiner, Art Unit 3689

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689